

REMARKS

Upon entry of the instant amendment to the claims, claims 1-9 will remain pending in the above-identified application and stand ready for further action on the merits.

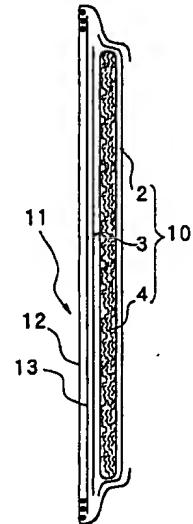
The addition of new claim 9 to the application does not incorporate new matter into the application as originally filed. For example, the subject matter of new claim 9 is fully supported by original Figure 2B which is reproduced below for the Examiner's convenience, along with the recitation of claim 9

In this respect, Figure 2B clearly shows that the inner sheet 13, outer sheet 12 and anti-leakage sheet 3 are different from each other.

Fig. 2B

9. (NEW) The shorts type disposable diaper according to claim 1 or 2, wherein:

    said inner sheet adjacent said anti-leakage sheet, said outer sheet adjacent said inner sheet and said anti-leakage sheet are different sheets from each other.



Support for newly added claim 9 also occurs at page 4, lines 5-10 and page 4, line 25 to page 5, line 3 of the specification. Accordingly, entry of the instant amendment is respectfully requested at present.

**35 USC § 103(a) Rejections**

Claims 1-4 and 6-8 have been rejected under the provisions of 35 USC § 103(a) as being unpatentable over **Watanabe US '353** (US 5,449,353), in view of **Coates US '583** (US 6,254,583) and further in view of **Sasaki US '380** (US 6,238,380).

Claim 5 has been rejected under the provisions of 35 USC § 103(a) as being unpatentable over **Watanabe US '353**, in view of **Coates US '583** and **Sasaki US '380**, further in view of **Iskra US '050** (US 5,021,050).

Reconsideration and withdraw of each of the above rejections is respectfully requested based on the following considerations.

**Legal Standard for Determining Prima Facie Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a

motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Present Invention and Its Advantages

The present invention provides for an advantageous diaper, which possesses unexpectedly good properties relating to fitability and sustained fit, as evidenced by properties such as fit, ease of putting on a wearer and resistance to sagging as described in the instant specification. (For example, see Table 1 at page 14 of the specification, which is reproduced below for the Examiner's convenience.)

TABLE 1

	Example				Comparative Ex.	
	1	2	3	4	1	2
Diaper Width W1 (mm)	380	380	300	600	380	300
Absorbent Core Width W2 (mm)	140	180	100	250	140	200
Body-surrounding Elastic Member Width W3+W4 (mm)	240	240	200	400	50	200
Stress $\sigma_w$ of Waist Opening Portion (gf/cm)	100	100	80	180	100	80
Stress $\sigma_b$ of Body-surrounding Portion (gf/cm)	25	25	20	100	25	20
Taber Stiffness of Absorbent Core (gf·cm)	5	5	1.5	10	5	1.5
Fit	A	A	A	B	C	B
Ease in Putting on Wearer	A	A	A	A	C	B
Resistance to Sagging	A	A	A	A	C	B

The advantages possessed by the claimed diaper results in part from use of a plurality of body-surrounding elastic members that are disposed at side portions of the diaper, wherein the body-surrounding elastic members are not disposed in at least a center portion of a body-surrounding portion wherein an absorbent core exists, and wherein the body-surrounding elastic members are disposed between an outer sheet which constitutes an outermost surface of the diaper and the anti-leakage sheet of the diaper.

By utilizing such a construction, fitability of the diaper is greatly improved, and at the same time bunching of the absorbent core is avoided, which produces other advantageous effects as discussed in the application.

*Distinctions Over the Cited Art*

***Rejection of Claims 1-4 and Claims 6-8***

The Examiner acknowledges that Watanabe US ‘353 fails to teach all elements of the claimed invention, as it does not disclose “*a pair of cuffs and the exterior member comprising inner and outer sheets.*” (See page 2, last paragraph of the Office Action.) The Examiner further states that Watanabe US ‘353 teaches a liquid impermeable anti-leakage sheet 3.

Coates US ‘583 is cited and relied on for its teaching of a pair of cuffs.

Sasaki US ‘380 is cited and relied upon for teaching an exterior member 3 having an inner 28 and an outer sheet 29, with body-surrounding elastic members 36 disposed there between.

The Examiner thus concludes at page 4, lines 4-8 of the office action that

*It would therefore be obvious to one of ordinary skill in the art at the time of invention to provide the article of Watanabe, as modified by Coates, with an exterior member having inner and outer layers, with elastic members disposed there between, as taught by Sasaki, to allow the elastic members to be placed adjacent to the core without having to sacrifice the thickness and rigidity of the core.*

However, based on applicant’s review of the applied art, it is submitted that the above conclusion of the USPTO Examiner is incorrect and must be reconsidered.

For example, it is initially noted that Watanabe US ‘353 teaches a backsheets 3, as opposed to an anti-leakage sheet as asserted by the Examiner, which even if similar in function are not actually the same (e.g., *typically being different in sheet number and constitution*).

Further, while the newly-cited Sasaki US '380 reference may teach or provide for an exterior member having two sheets, the Sasaki US '380 reference does not teach or suggest the use of an anti-leakage sheet between an exterior member described therein and an absorbent member as herein claimed. The cited Sasaki US '380 reference also does not teach opposing ends of the exterior member outer sheet extending beyond and folded over each opposite end of the absorbent core as claimed (e.g., *see instant claims 1 and 2, lines 3-4 from bottom*).

For the Examiner's convenience, the following summary "Comparison Table A" is provided to facilitate the showing and highlighting of certain other distinctions between the instant invention as claimed (e.g., see claims 1, 2 and 9) and the cited art of Watanabe US '353 and Sasaki US '380.

### Comparison Table A

### **Present Invention**

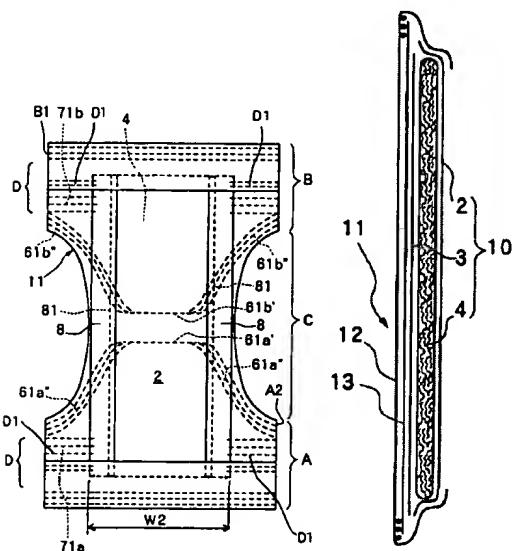
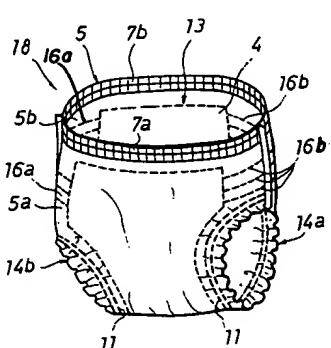
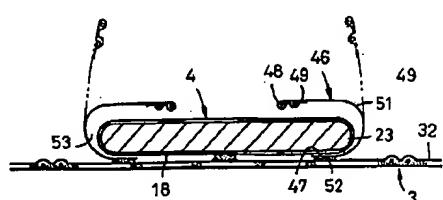


Figure 5

Watanabe US '353



esaki US '380



## Top sheet 2

## Core 4

### Anti-leakage Sheet 3

### **Exterior Member:**

- (a) Inner sheet 13
- (b) Body-surrounding elastic members 71
- (c) Outer sheet 12

top sheet 2

○

○ **back sheet 3**

×  
○  
ela  
×

## ○ topsheet 2

8

## ○ inner layer sheet 28

○: Means that the claimed limitation is present in cited art.

×: Means that the instantly claimed limitation (see claim 1) is not present in the cited art.

As can be seen upon reviewing the above “*Comparison Table A*”, the Watanabe US ‘353 reference fails to provide for an inner sheet 13 and outer sheet 12 as occurs in the exterior member of the instant inventive diapers; and the cited Sasaki US ‘360 reference fails to provide for an inner sheet 13 and body surrounding elastic members 71 as found in the exterior member of the instant

inventive diapers. The remaining Coates US '583 reference does *not* cure these deficiencies of Watanabe US '353 and Sasaki US '360.

Accordingly, it is submitted that no teaching or disclosure is found in the cited Watanabe US '353, Coates US '583 and Sasaki US '360 references, that would allow one of ordinary skill in the art to arrive at the instant invention as recited in current claims 1-9. As such, the outstanding rejection of pending claims 1-4 and 6-8 must be withdrawn at present.

***Rejection of Claim 5***

The outstanding rejection of claim 5 is similarly without basis, inasmuch as claim 5 depends from claim 1, and the remaining cited reference of Iskra US '050 is simply relied upon for its teachings regarding Tabor Stiffness of an absorbent core. (*See page 5 of the office action, penultimate paragraph.*) That is, the cited art of Iskra US '050 is incapable of curing the deficiencies of the other applied references (*i.e.*, Watanabe US '353, Coates US '583 and Sasaki US '360).

Based on such distinctions it is submitted that a proper *prima facie* case of obviousness has *not* been established, since the cited art being applied against the pending claims does *not* provide for or otherwise each of the elements of the instantly claimed invention, and provides no motivation that would allow one of ordinary skill in the art to arrive at the instant invention as claimed. Absent such teaching and motivation in the cited art, the USPTO's outstanding rejections under 35 USC § 103(a) are *not* sustainable.

**CONCLUSION**

Based on the amendments and remarks presented herein, the Examiner is respectfully requested to issue a notice of Allowance clearly indicating that each of pending claims 1-9 is allowed and patentable under the provisions of Title 35 of the United States Code. In view of the above, the

application is believed to be in condition for allowance, and an early indication of the same is earnestly solicited.

Should the Examiner find that any matters remain unresolved after giving proper consideration to the instant reply, the Examiner is invited to contact to contact the undersigned at the telephone number indicated, in order to help resolve such matters and expedite the instant claims to allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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